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Wood, Herron & Evans, LLP
2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202

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In re Application of	:	CENTRAL REEXAMINATION UNIT
Roger Streets et al.	:	
Application No. 10/664,052	:	SECOND ORDER TO
Filed: September 16, 2003	:	SHOW CAUSE
Attorney Docket No. AOI-73	:	

This is in response to the applicants' communication entitled Response To The Order To Show Cause filed August 2, 2006, requesting that prosecution of the above-identified application be continued.

Applicants' response is before the Office of Patent Legal Administration (OPLA) for decision.

BACKGROUND

1. The present application ("present reissue proceeding") was filed March 8, 2002, for reissue of U.S. Patent No. 6,305,143 (the '143 patent), which issued October 23, 2001.
2. On December 14, 2005, in the present reissue proceeding, the examiner issued a non-final office action. In response, on December 14, 2005, a reply was filed.
3. A review of the Office's financial records for the '143 patent reveals that the 3.5 year maintenance fee due and not paid could have been paid during the period from October 23, 2004 through April 25, 2005 (April 23, 2005 was a Saturday), or with a surcharge during the period from April 26, 2005 through October 24, 2005 (October 23, 2005 was a Sunday). As a result, the '143 patent expired after midnight on October 24, 2005, for failure to pay the 3.5 year maintenance fee due. See 1301 *Official Gazette* 87 (December 20, 2005).
4. On July 5, 2006, in the present reissue proceeding, an Order To Show Cause was mailed stating that the '143 patent had expired for failure to pay the first maintenance fee, the Director of the USPTO no longer had the authority under 35 U.S.C. § 251 to reissue the '143 patent, and the Office intended to terminate the present reissue proceeding and hold the application for reissue of the '143 patent to be an abandoned application. Applicants were given a period of 30 DAYS from the mailing of the ORDER to show cause why the Office should not terminate the present reissue proceeding.
5. In response, on August 2, 2006, in the present reissue proceeding, the present communication entitled Response To The Order To Show Cause was filed. Applicants request that prosecution of the application be continued as the owner of the '143 patent filed on August 2, 2006, the requisite maintenance fee and surcharge along with a petition and fee to accept late payment of the maintenance fee based upon the patent owner's unintentional

failure to timely pay the maintenance fee.

37 CFR 1.181(f) states, in part:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

This provision of the rules is a statement that there is no assurance that any petition filed will be granted. Action shall not be taken based upon an assumption of a future grant of a petition. In this instance, the mere filing of the August 2, 2006 petition did act to restore the '143 patent to status as a live patent. As such, the '143 patent remains in the status of an expired patent for failure to pay the first maintenance fee. Accordingly, the Director of the USPTO does not have the authority under 35 U.S.C. § 251 to reissue the '143 patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993).

As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only "for the unexpired part of the term of the original patent." Thus, when **Morgan's original patent expired** on August 19, 1992, the Commissioner was divested of his reissue authority because there no longer was an unexpired term of the patent for which Morgan's patent could be reissued. Morgan's appeal thus became moot." [990 F.2d at 1231, 26 USPQ2d at 1393; Emphasis added]

Because the Director does not have the authority under 35 U.S.C. § 251 to reissue the patent, the Office intends to terminate the present reissue proceeding, and thereafter hold the application for reissue of the '143 patent to be an abandoned application.

In view of the above, applicants' request that the prosecution of the above-identified application be continued is dismissed, and the response to the show cause order of July 5, 2006 is found not to be sufficient to provide basis for examination of the application. The response to the show cause order of July 5, 2006 is, however, sufficient to the extent that the Office will not terminate the present reissue proceeding at this time. Rather, based on the filing of the August 2, 2006 petition to accept late payment of the maintenance fee, jurisdiction over the reissue proceeding is being retained in the Office of Patent Legal Administration (OPLA), to provide the applicants with an opportunity to provide a second showing of cause as to why the Office should not terminate the present reissue proceeding, as will be discussed in the below conclusion.

CONCLUSION

1. Applicants are hereby being provided with a period of **SIX(6) MONTHS** from the mailing of this SECOND SHOW CAUSE ORDER to again show cause why the Office should not terminate the present reissue proceeding.

2. If applicants propose to show cause why the present reissue proceeding should not be terminated, **applicants' showing must include** either:

A) A copy of a favorable determination on the merits of the August 2, 2006 petition to accept late payment of the maintenance fee, or

B) An explanation of why the proceeding should continue even though the original patent has expired.

Applicants must also show due diligence when providing a response to this SECOND SHOW CAUSE ORDER. If applicants make a showing, the showing will be evaluated as to whether due diligence was exercised in providing the showing, and as to whether the showing provides sufficient basis why the present reissue proceeding should not be terminated.

3. **Failure to respond to this SECOND SHOW CAUSE ORDER within the SIX (6) MONTH period that has been set will result in the proceedings being terminated by default.** If the present reissue proceeding is terminated by default, jurisdiction over the application for reissue of the '143 patent would then be returned to Technology Center 3634 for processing as an abandoned application.
4. Jurisdiction over the file for reissue application 10/664,052 is being retained in the Office of Patent Legal Administration (OPLA), pending a response by applicants, or the expiration of time for a response.
5. Telephone inquiries related to this decision should be directed to Fred Silverberg, Senior Legal Advisor, at (571) 272-7719 or, in his absence to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy



Conferee: Fred A. Silverberg, Senior Legal Advisor